

REMARKS

Claims 1-44 are pending.

As an initial matter, Applicants note that the Office Action does not appear to provide any response to several remarks set forth in the previously filed Response to Office Action dated July 13, 2006, including Applicants' remarks relating to claim rejections that the Examiner maintained in the most-recent Office Action of January 11, 2007. As set forth in M.P.E.P. § 707.07(f), "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of applicant's argument and answer the substance of it." Since the Office Action does not answer any of Applicants' arguments relating to the rejections that have been maintained, Applicants respectfully submit that any further office action should be non-final and should provide a full answer to all of Applicants' remarks.

In the Office Action, claims 37, 40, and 41 were rejected under 35 U.S.C. § 103(a) based on International Application No. WO 90/15215 to Jeong ("Jeong") in view of U.S. Patent No. 2,302,661 to Benson ("Benson").

Applicants respectfully submit that the Section 103(a) rejection based on Jeong and Benson should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all of the claim limitations. M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a

manner resulting in the claimed invention. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine the references. § 2143.02; *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant’s disclosure.” § 2143.01 (citing *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991)).

The Office Action lacks any showing of a proper motivation, teaching, or suggestion to combine or modify the cited references in a manner that would result in Applicants’ claimed invention. As apparently acknowledged in the Office Action, Jeong does not disclose, *inter alia*, a device “configured so that [an] end portion of [a] cover opening limiter moves into [a] base recess when [a] cover is moved from [an] open position to [a] closed position,” as recited in claim 37. Benson does not provide any motivation, teaching, or suggestion that would remedy that deficiency.

Jeong relates to an article, such as a jewelry box, that has an integrally formed hinge. Benson, on the other hand, concerns a hinge structure associated with recessed lighting that is secured to a building structure. See, e.g., pg. 1, left col., lines 34-40. Contrary to the obviousness assertion in the Office Action, one of ordinary skill in the art would not have had any reason to modify Jeong’s jewelry box hinge with any feature of Benson’s recessed lighting hinge, because jewelry boxes and recessed lighting are completely different fields of art.

In addition, absolutely nothing supports the Office Action’s assertion that “[i]t would have been obvious . . . to construct the hinge as taught by Benson into the device

of Jeong for the purpose of hiding a portion of the hinge.” Office Action at pgs. 2-3. For example, Benson does not refer to “hiding” a portion of a hinge and, for at least this reason, fails to support the Office Action’s obviousness assertion.

Moreover, one of ordinary skill in the art would not have had any legitimate reason to modify Jeong’s hinge to include any portion of Benson’s hinge. For example, contrary to the assertions in the Office Action, one of ordinary skill in the art would not have had any suggestion or motivation to substitute Benson’s arcuate hinge portion 44 in place of the C-shaped plate spring 90 disclosed in Jeong “for the purpose of hiding a portion of the hinge” because 1) Jeong already appears to disclose hiding a portion of the C-shaped plate spring 90, and 2) such a modification would destroy the principle of operation of Jeong’s hinge. Jeong discloses that “two ends of the spring 90 [are] engaged with the holes 39 and 29 provided in [a] body 30 and [a] cover [20] respectively” to ensure resilient opening and closing of a box (Jeong at page 3, lines 11 and 22-25, and page 4, lines 10-13), and Figs. 7A and 7B of Jeong show the ends of the spring 90 recessed into the holes 39 and 29. Since the spring 90 is engaged with, and recessed into, the holes 39 and 29, portions of the spring 90 are already hidden and, thus, one of ordinary skill in the art would not have modified the article of Jeong to include any feature of Benson “for the purpose of hiding a portion of the hinge,” as alleged in the Office Action at page 3.

Furthermore, one of ordinary skill in the art would not have modified Jeong’s spring 90 to permit it to move into, and out of, either of the holes 39 and 29 because such a hypothetical modification would destroy the operational principles of Jeong’s hinge, which has the spring 90 ensure resilient opening and closing of a box by

maintaining engagement of ends of the spring 90 within the holes 39 and 29. In other words, the hypothetical modification of Jeong's hinge would destroy the disclosed operational principles of Jeong's hinge. Consequently, there is no motivation, suggestion, or teaching to modify or combine the references as proposed in the Office Action. See M.P.E.P. § 2143.01 (VI).

For at least these reasons, there is no *prima facie* case of obviousness and independent claim 37 is allowable over Jeong. Claims 40 and 41 depend from claim 37 and, thus, should be allowable for at least the same reasons claim 37 is allowable.

In the Office Action, claims 38 and 39 were rejected under 35 U.S.C. § 103(a) based on Jeong in view of Benson and further in view of U.S. Patent No. 4,807,773 to Tsai ("Tsai").

Applicants respectfully submit that the rejection of claims 38 and 39 should be withdrawn because claims 38 and 39 depend from claim 37 and, therefore, are allowable for at least the same reasons claim 37 is allowable.

Claims 1-4, 42, and 43 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,283,298 to Seidler ("Seidler") in view of Tsai. In the Office Action at page 4, the Examiner acknowledges that "Seidler fails to show . . . first and second magnets coupled with the base and cover and the angular extent being less than 180 degrees and greater than or equal to 100 degrees." Despite these acknowledged deficiencies, the Office Action at pages 4-5 alleges that "[i]t would also have been an obvious matter of design choice to construct one first magnet at the base and the second magnet at the cover," and that "[i]t would have been obvious . . . to construct the angular extent . . . since it has been held that where the general conditions of a claim

are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.”

Applicants respectfully submit that the Section 103(a) rejection of claims 1-4, 42, and 43 should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. *Prima facie* obviousness has not been established because (1) neither Seidler, nor Tsai, nor any combination thereof, teaches or suggests all of the features recited in claims 1-4, 42, and 43; and (2) even hypothetically if some combination of those references were to yield all of the claimed features, the Office Action does not provide a proper motivation, suggestion, or teaching to combine or modify the references in a manner resulting in Applicants’ claimed invention.

Regardless of whether Seidler could be combined with Tsai as proposed in the Office Action, such a hypothetical combination does not provide any disclosure or suggestion of a device including, among other features “at least one first magnet associated with [a] base and at least one second magnet associated with [a] cover, the first and second magnets coupling the base and the cover together so as to permit movement of the cover with respect to the base, in a generally hinge-like manner, between a closed position in which the cover covers [an] opening of [a] compartment and an open position in which access to the compartment is permitted,” as recited in Applicants’ claim 1. Furthermore, the hypothetical combination of Seidler and Tsai does not disclose or suggest a device “configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from the closed position to the open position, the cover moves with respect to [a] base up to a maximum angular extent

of less than 180 degrees and greater than or equal to about 100 degrees,” as recited in claim 1.

Nothing provides any motivation, suggestion, or teaching for the purported modification of Seidler to include the first and second magnets recited in claim 1. Although Seidler refers to a closure mechanism that may be a “magnetic assembly” (col. 3, lines 63-67), Seidler does not provide any details of how such a “magnetic assembly” would be arranged. For example, nothing provides any indication of whether the magnetic assembly would have more than one magnet or only a single magnet, and there is no disclosure of how any magnet might be arranged. Thus, neither Seidler nor any other source cited in the claim rejection provides disclosure or suggestion of “at least one first magnet associated with [a] base and at least one second magnet associated with [a] cover,” as recited in claim 1. Moreover, nothing cited in the claim rejection provides any motivation, teaching, or suggestion for modifying Seidler to include “first and second magnets coupling [a] base and [a] cover together so as to permit movement of the cover with respect to the base, in a generally hinge-like manner, between a closed position in which the cover covers [an] opening of [a] compartment and an open position in which access to the compartment is permitted,” as recited in claim 1.

Applicants also respectfully submit that rejection of claims 1-4, 42, and 43 should be withdrawn because nothing supports the assertions in the Office Action at pages 4-5 regarding the purported “design choice.” These conclusory assertions lack any factual support in the record and reflect an apparent attempt to reject the claims in a hindsight fashion based on Applicants’ disclosure. If the Examiner insists on maintaining the

claim rejection based on this unsupported “design choice” reasoning, Applicants respectfully repeat the request that the Examiner supply a personal affidavit explaining the basis for the “design choice” assertions, so that Applicants will be able to respond in kind. (See 37 C.F.R. § 1.104(d)(2)).

In addition to the fact that there is no disclosure or suggestion of the features recited in claim 1 relating to first and second magnets, the purported combination of Seidler and Tsai also does not disclose or suggest a device “configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees,” as recited in claim 1. Contrary to the Examiner’s apparent assertion, neither one of the cited references discloses the “general conditions” of the claim. For example, the cited references do not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Here again, rather than setting forth a *prima facie* case of obviousness, the Office Action appears to reject the claims in a hindsight fashion based on Applicants’ own disclosure, which is contrary to the guidance of the M.P.E.P. See, e.g. § 2142.

For at least these reasons, Applicants respectfully submit that the Section 103(a) rejection of independent claim 1 and dependent claims 2-4, 42, and 43 should be withdrawn.

In the Office Action, claims 5-8 were rejected under 35 U.S.C. § 103(a) based on Seidler in view of Tsai and Jeong. Applicants respectfully submit that the rejection of

claims 5-8 should be withdrawn at least because claims 5-8 depend from claim 1 and, therefore, are allowable for at least the same reasons claim 1 is allowable.

Claims 1 and 9 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,135,012 to Kamen et al. ("Kamen et al."). The Office Action at page 7 acknowledges that "Kamen et al fails to show the angular extent of less than 180 degrees and greater than or equal to about 100 degrees," but, in a legally improper manner similar to the above-mentioned rejection of claim 1 based on Seidler and Tsai, the Office Action alleges that "[i]t would have been obvious . . . to construct the angular extent . . . since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

Applicants respectfully submit that the Section 103(a) rejection of claims 1 and 9 should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. Kamen et al. does not provide any disclosure or suggestion of a device "configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees," as recited in claim 1. Despite the Examiner's apparent assertion, Kamen et al. does not disclose the "general conditions" of the claim. For example, the cited reference does not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Once again, rather than setting forth a *prima facie* case of obviousness,

the Office Action appears to reject the claims in a hindsight fashion based on Applicants' disclosure. Consequently, the Section 103(a) rejection of independent claim 1 and dependent claim 9 should be withdrawn.

In the Office Action, claims 10, 11, 25-28, and 33-35 were rejected under 35 U.S.C. § 103(a) based on Kamen et al. in view of Tsai. The Office Action at page 7 acknowledges that Kamen et al. does not disclose "first and second plate-shaped members each having magnets coupling to each other by stacking on one another" Nevertheless, the Office Action at page 8 asserts that [i]t would have been obvious . . . to employ the particular base as taught by Tsai into the device of Kamen et al. . . . "

Applicants respectfully submit that the Section 103(a) rejection of claims 10, 11, 25-28, and 33-35 should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. For example, the purported combination of Kamen et al. and Tsai does not disclose or suggest a "base compris[ing] a first member and a second member, wherein the first and second members comprise magnets coupling the first and second members together with one of the members being stacked on the other member," as recited in independent claim 25. In addition, the cited references do not disclose or suggest the subject matter of claim 10, which depends from claim 1.

Nothing in either Kamen et al. or Tsai provides any motivation or suggestion for modifying the Kamen et al. reference to include the vertically assembled compact of Tsai. Further, even if Tsai were to be combined with Kamen et al. in the hypothetical manner proposed in the Office Action, the subject matter of claims 10 and 25 would not result, because neither one of those references discloses or suggests a base

comprising first and second members including magnets coupling the members together with one of the members stacked on the other member, as recited in claims 10 and 25. Although Kamen et al. shows a “base 112” impregnated with magnetic particles 146 and a lid 114 impregnated with magnetic particles 148, Kamen et al. does not disclose or suggest the recited base comprising first and second members including magnets coupling the members together with one of the members stacked on the other member. Tsai also does not provide any disclosure or suggestion of such subject matter. Indeed, the compact of Tsai has body portions assembled together by means of a pivot 13 tightly and elastically inserted into a pivot hole 14, without having any magnets coupling base members together. Col. 2, lines 2-14. Accordingly, even if Tsai were to be combined with

Kamen et al., the subject matter recited in claims 10 and 25 would not result.

Applicants also respectfully submit that the Section 103(a) rejection of claims 10, 11, 25-28, and 33-35 should be withdrawn because the cited references do not provide any disclosure or suggestion of a device “configured to limit an extent of generally hinge-like movement of [a] cover so that when the cover is moved from [a] closed position to [an] open position, the cover moves with respect to [a] base up to a maximum angular extent of less than 180 degrees and greater than or equal to about 100 degrees,” as recited in claim 25 and in claim 10 (i.e., by virtue of its dependency from claim 1). As noted above, Kamen et al. does not appear to mention the extent of hinge-like movement of a cover or have any disclosure or suggestion of any maximum angular extent. Moreover, Tsai does not remedy the deficiencies of Kamen et al.

Accordingly, the Section 103(a) rejection of independent claim 25 and dependent claim 10 should be withdrawn.

For at least these reasons, claims 10 and 25 should be allowable over the cited references. Since claim 11 and claims 26-28 and 33-35 depend from claims 10 and 25, respectively, those dependent claims should also be allowable for at least the same reasons as the claims from which they depend are allowable.

In the Office Action at pages 11-12, claims 29-32 and 36 were rejected under 35 U.S.C. §103(a) based on “Kamen et al. in view of Tsai . . . , and further in view of Jeong in view of Benson.” Applicants respectfully submit that the rejection of claims 29-32 and 36 should be withdrawn at least because claims 29-32 and 36 depend from claim 25 and, therefore, are allowable for at least the same reasons claim 25 is allowable. Moreover, there is no motivation or suggestion to combine the references as proposed by the Examiner.

In the Office Action at pages 8-10, claims 12-21 were rejected under 35 U.S.C. § 103(a) based on Kamen et al. in view of Jeong and Benson. Applicants respectfully submit that the Section 103(a) rejection of claims 12-21 should be withdrawn because there would have been no motivation or suggestion for one of ordinary skill in the art to combine features of Kamen et al., Jeong, and Benson without the hindsight benefit of Applicants’ disclosure. Kamen et al., Jeong, and Benson are directed to very different subject matter. For example, Kamen et al. relates to a compact and discusses how “[t]he use of a hinge is disadvantageous because it sets a practical limit on how thin the compact case can be” Col. 1, lines 21-31. In contrast, Jeong relates to a relatively thick article, such as a jewelry box, which is integrally-formed with a hinge. See, for

example, the title and drawings of the Jeong reference. In further contrast, Benson concerns a hinge structure associated with recessed lighting that is secured to a building structure. See, e.g., pg. 1, left col., lines 34-40. In other words, each of the references relates to a completely different field of art, and the Kamen et al. and Jeong references teach away from one another. Accordingly, one of ordinary skill in the art would not have had any legally sufficient motivation or suggestion for combining the Jeong, Kamen et al., and Benson disclosures.

Applicants also respectfully submit that the rejection of claims 12-21 should be withdrawn because neither Kamen et al., Jeong, Benson, nor any combination thereof, discloses or suggests a device including, among other features, “first and second magnets coupl[ing a] base and [a] cover together during [a] generally hinge-like movement of the cover between [an] open position and [a] closed position,” as recited in claim 12. For example, Kamen et al. does not disclose or suggest the magnetic particles 146 and 148 providing coupling during any hinge-like movement of the lid 114. Further, neither Jeong nor Benson appears to disclose any magnets.

For at least these reasons, independent claim 12 and dependent claims 13-21 should be allowable.

In the Office Action at pages 10-11, claims 22-24 were rejected under 35 U.S.C. § 103(a) based on “Kamen et al. in view of Jeong and Benson . . . , and further in view of Tsai.” Applicants respectfully submit that the rejection of claims 22-24 should be withdrawn because claims 22-24 depend from allowable claim 12 and, therefore, are allowable for at least the same reasons claim 12 is allowable. Moreover, there is no motivation or suggestion to combine the references as proposed by the Examiner.

In view of at least the reasons explained above, all of the claim rejections should no longer be applicable and all of the pending claims should be allowable. If the Examiner believes a telephone conversation or interview might advance prosecution, the Examiner is invited to call Applicants' undersigned representative (571-203-2774).

Applicants respectfully request reconsideration of this application, withdrawal of all of the claim rejections, and timely allowance of the pending claims.


The Office Action contains a number of statements relating to the claims and the cited references. Applicants decline to subscribe to any statement in the Office Action, regardless of whether it might be specifically mentioned above. In particular, Applicants decline to subscribe to any characterization of the claims or the cited references.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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